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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,679	06/20/2001	Martin Frederick Pera	14727	6362
75	90 02/25/2003			
SCULLY, SCOTT, MURPHY & PRESSER			EXAMINER	
400 Garden City Plaza Garden City, NY 11530			WOITACH, JOSEPH T	
			ART UNIT	PAPER NUMBER
			1632	
			DATE MAILED: 02/25/2003	
				9
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Please find below and/or attached an Office communication concerning this application or proceeding.



Pera, M.

Office Action Summary

Application No. Applicant(s)

09/885,679

Art Unit

Examiner

Joseph Woitach

1632



A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE MONTH(S) FROM THE MALING DATE OF THIS COMMUNICATION. - Command at time freely be available under the previouses of 37 CPT 1.136 (d.). In no event, however, may a reply be timely filed after SIX 191 MONTHS from the - Command of time freely be securified before, the state that they (all) apply, and public the statution, minimum of thinty (100 days will be considered timely. - If 100 period for emply is specified above, the maximum statutory point and till apply and will septic SIX (81 MONTHS from the maining date of this communication. - If 100 period for emply is specified above, the maximum statutory point and till apply and will septic SIX (81 MONTHS from the maining date of this communication. - If 100 period for emply is specified above, the maximum statutory point and till apply and will septic SIX (81 MONTHS from the maining date of this communication. - If 100 period for emply is specified above, the maximum statutory point and statution. - If 100 period for emply is specified above, the maximum statutory point and state of the communication. - A public of the state of the communication of the state of the specified apply to state, cause the application. - A proper state of the specified above, the specified application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. - Disposition of Claims - If 100 period in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. - Disposition of Claims - If 100 period in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. - A publication Pepers - If 100 period in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. - A publication Pepers - If 100 period in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. - A publication Pepers - If 100 period in accord	The MAILING DATE of this communication appears on the cover sheet with the correspondence address				
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6 Claim(s)	4	a) Of the above, claim(s)	is/are withdrawn from consideration.		
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Application Papers 9) ☐ The specification is objected to by the Examiner. 10) ☒ The drawing(s) filed on	7) 🗌	Claim(s)	is/are objected to.		
Application Papers 9) ☐ The specification is objected to by the Examiner. 10) ☒ The drawing(s) filed on	8) 💢	Claims <u>1-37</u>	are subject to restriction and/or election requirement.		
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3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)	_	•			

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DETAILED ACTION

This application filed June 20, 2001 claims benefit to foreign applications PR1327, filed

November 8, 2000, and PQ8242, filed June 20, 2000, both in Australia.

Applicants' amendment filed December 9, 2002, paper number 8, has been received and

entered. Claim 5 has been amended. Claims 38-44 have been cancelled. Claims 1-37 are

pending and currently under examination.

Upon reconsideration of the pending claims a new restriction requirement is set forth

below.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-29, drawn to a preparation of undifferentiated embryonic stem cells and

methods of culturing, classified in class 435, subclass 1.1 and class 435, subclass

325.

 \coprod . Claims 30-35, drawn to a preparation of somatic cells and a method of producing

a somatic cell from an embryonic stem cell, classified in class 435, subclass 1.1

and class 435, subclass 325.

Ш. Claims 36 and 37, drawn to a insulin or insulin analogue induced factor, unclassifiable because the nature of the analogue is not clearly set forth in the claim.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to three different and unique types of methods directed obtaining and maintaining different cell types. In the instant case the different inventions, an ES cell, a progenitor cell and a somatic cell, are drawn to products which are materially different each having different phenotypic characteristics which are used to define the cell itself. Further, the various cell types can be obtained from a tissue by simple and routine isolation methods known and practiced in the art. The methods require different materials to practice, require different method steps, and result in a materially different products.

Inventions I-II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the product of group III, a insulin induced factor, is not present in the composition of cells or used in any of the methods of groups I-II.

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In addition, if group I is elected a further election of species is required.

This application contains claims directed to the following patentably distinct species of the claimed invention: specifically claims 7, 16 and 27 recite several structurally unrelated, but functionally related species of an antagonist of BMP-2. The specific species antagonist include fetuin, noggin, chordin, gremlin, follistatin, cerberus, amnionless, DAN, ectodomain of BMPR1A, ligand binding domain of BMP-2, insulin or an insulin analogue. One of the specific species must indicated for examination.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-6, 12-15, 18-20, 25, 26 and 29 are generic to all species, claims 7 and 27 are generic to each fetuin, noggin, chordin, gremlin, follistatin, cerberus, amnionless, DAN, ectodomain of BMPR1A, ligand binding domain of BMP, claims 8-11 are generic to noggin alone, and claims 16, 17, 21-23, 28 are generic to inulin or an insulin analogue.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after Art Unit: 1632

the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (703) 308-2141.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.

Joseph T. Woitach

Joe Wortacl